



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,144	06/27/2003	Robert Wayne Gravely	1030.004	1143

36790 7590 04/02/2007
TILLMAN WRIGHT, PLLC
PO BOX 471581
CHARLOTTE, NC 28247

EXAMINER

RACHUBA, MAURINA T

ART UNIT	PAPER NUMBER
----------	--------------

3723

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/604,144

Applicant(s)

GRAVELY ET AL.

Examiner

Maurina Rachuba

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-28 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-28, 30 and 34 is/are allowed.
- 6) ☒ Claim(s) 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of group III, claims 26-34 in the reply filed on 30 November 2005 is acknowledged.

Terminal Disclaimer

2. The terminal disclaimer filed on 28 July 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,050,163 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 31-33 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gakhar et al, 5,555,788, as set forth in the Office action mailed 29 September 2006.

Allowable Subject Matter

5. Claims 26-28 and 34 are allowed.

Response to Arguments

6. Applicant's arguments filed 29 December 2006 have been fully considered but they are not persuasive. Applicant argues that Gakhar fails to provide any teaching, suggestion or motivation that would lead one of ordinary skill to modify the blade disclosed by Gakhar such that "the cumulative opening area of the plurality of cavities

equals approximately six percent of a cutting triangle of a circular saw blade.” Applicant further argues that Gakhar fails to disclose or teach the necessary conditions under which the ordinary artisan would have arrived at the saw blade having the recited recitation. Applicant contends that the proposition of *In re Aller* applies only to finding the optimum value of a *disclosed range*, the optimum value being related to the *disclosed function* or the *disclosed desired result*. (emphasis added). The examiner disagrees.

In re Aller states in part :

”Normally, it is to be expected that a change in temperature, or in concentration, or in both, would be an unpatentable modification. Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Dreyfus*, 22 C.C.P.A. (Patents) 830, 73 F.2d 931, 24 USPQ 52 ; *In re Waite et al.*, 35 C.C.P.A. (Patents) 1117, 168 F.2d 104, 77 USPQ 586 . Such ranges are termed “critical” ranges, and the applicant has the burden of proving such criticality. *In re Swenson et al.*, 30 C.C.P.A. (Patents) 809, 132 F.2d 1020, 56 USPQ 372 ; *In re Scherl*, 33 C.C.P.A. (Patents) 1193, 156 F.2d 72, 70 USPQ 204 . However, even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art. *In re Sola*, 22 C.C.P.A. (Patents) 1313, 77 F.2d 627, 25 USPQ 433 ; *In re Normann et al.*, 32 C.C.P.A. (Patents) 1248, 150 F.2d 708, 66 USPQ 308 ; *In re Irmscher*, 32 C.C.P.A. (Patents) 1259, 150 F.2d 705, 66 USPQ 314 . More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Swain et al.*, 33 C.C.P.A. (Patents) 1250, 156 F.2d 239, 70 USPQ 412 ; *Minnesota Mining and Mfg. Co. v. Coe*, 69 App. D.C. 217, 99 F.2d 986, 38 USPQ 213 ; *Allen et al. v. Coe*, 77 App. D. C. 324, 135 F.2d 11, 57 USPQ 136.”

It is the examiner's position that the claimed range of claim 31 is not critical to the functioning of applicant's saw blade. This conclusion is based on applicant's disclosure, [0025] "It has been determined by experiment that the total opening area of the cavities 30 preferably should minimally approximate 6% of a "cutting triangle" of the circular saw blade 10.". There is no disclosure that the size of the cavity is critical to the functioning of the cavity. Applicant's own admission is that routine experimentation determined the preferred size of the cavities. Further, it is noted that applicant has claimed that the cavities are "sufficient" to receive liquid for transport. There is nothing in the disclosure of Gakhar that would prevent the cavities from transporting liquid. The examiner also notes that applicant argues that the slots of Gakhar are for a different purpose than those disclosed by applicant.

MPEP 2144 states in part:

The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. >See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."); < *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991) (discussed below). Although *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done" (emphasis added), reading the quotation in context it is clear that while there must be motivation to make

Art Unit: 3723

the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.”

Here, it is the examiner's position that the saw blade is the same as applicant's, albeit lacking the claimed preferred cavity size, and that one of ordinary skill in the art would have found it obvious to make the cavities of the desired size, *In re Aller*.

Regarding the number of cavities, please refer to figure 8, and regarding the cavity area, please refer to the argument above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

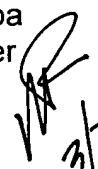
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurina Rachuba whose telephone number is 571 272 4493. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272 4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Maurina Rachuba
Primary Examiner
Art Unit 3723


3/22/07